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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GROSS, KENNETH A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/602,261

Applicant(s)

HANSMANN ET AL.

Examiner

Kenneth A Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because of the following reasons: the following phrase “the user-defining configuring and starting of an application” should be modified with commas in the appropriate places. The phrase “stored in his chip card” should be modified by replacing “his” with “this”. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: the term “which are” should be replaced with “which is”. Claim 26 is objected to because of the following informalities: the term “whatever is” should be deleted. Claim 8 is objected to under 37 CFR 1.75(b) as being a duplicate claim of Claim 7. Claim 27 depends on Claim 16, however, Claim 16 makes no reference to “determining”. It is understood that Claim 27 actually depends on Claim 17, and is being treated as such. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 7 recites the limitation “the address information is shown”. It is unclear from this limitation what it means to “show” address information. Claim 11 recites the limitation “the card reader”. There is insufficient antecedent basis for this limitation in the claim. Claim 14 recites the limitations “the card” and “the address information”. There is insufficient antecedent basis for these limitations in the claim. Claim 17 recites the limitation “the identifying data”. There is insufficient antecedent basis for this limitation in the claim. Claim 20 recites the limitation “the card reader”. There is insufficient antecedent basis for this limitation in the claim. Claim 21 recites the limitations “the non-volatile memory” and “the chip card”. There is insufficient antecedent basis for these limitations in the claim. Claim 23 recites the limitation “the first log-on”. There is insufficient antecedent basis for this limitation in the claim. Claim 24 recites the limitation “the chip card”. There is insufficient antecedent basis for this limitation in the claim. Claim 25 is unclear as to how the driver is part of the agent, when in Claim 24 it is stated that the agent loads the driver. Claim 27 recites the limitation “inserting identifying data”. It is unclear from this limitation where the identifying data is being inserted. Claim 27 is generally unclear and repeats an element of Claim 17 in the final step. Claims that depend from 27 are rejected and have not been further treated on the merits because the 112 problems are so severe. Claim 28 recites the limitation “when the identifying data do not match”. It is unclear from this limitation to what the identifying data is being matched.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 17, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowlow (U.S. Patent Number 6,260,078).

In regard to Claim 1, Fowlow teaches the following: (a) a token comprising a non-volatile memory (Column 16, lines 35-38 and Column 15, lines 37-48) for storing unique software attribute (“class name” as specified in Column 13, lines 20-21), a volatile memory (Column 15, lines 36-37), and a processor (Column 15, lines 33-34); (b) an apparatus for establishing communications between the token and data-processing device (Column 16, lines 43-47); and (c) a data-processing device comprising applications or software components (Column 16, lines 48-51), a register for registering software (Columns 11, lines 47-51), and a communications agent (Column 16, lines 43-47).

In regard to Claim 17, Fowlow teaches the following: (a) establishing a communications between the token and data-processing device (Figure 4, item 406); (b) reading the identifying data stored in the token (Column 13 lines 20-21); (c) determining whether the software is available at the data-processing device using the identifying data (Figure 5, items 502, 506, and 508); and (d) loading the software when found on the processing device (Figure 5, items 504, 512, and 514). Claim 31 corresponds directly with Claim 17 and is rejected for the same reasons as Claim 17.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7, 9, 18, 21-23, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowlow (U.S. Patent Number 6,260,078) in view of Powers (U.S. Patent Number 5,521,362).

In regard to Claim 2, Fowlow teaches the apparatus of Claim 1, but does not teach that the token is a chip card. Powers, however, teaches a chip card with volatile and non-volatile memory (Figure 2, item 18) and a microprocessor (Figure 2, item 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create the apparatus for the user-defined configuring of applications by means of a token, as taught by Fowlow, where the token is a chip card, as taught by Powers, since a chip card is a smaller and more portable device. Claim 18 corresponds with Claim 2 and is rejected for the same reasons as Claim 2.

In regard to Claim 3, Powers teaches a chip card, which is a portable data-processing device.

In regard to Claim 4, the chip card is obviously a connector, because it needs to be able to connect to the network and eventually a server machine.

In regard to Claim 5, Fowlow teaches that the identifying attribute is the name of a class, which is unique to each class (Column 11, lines 47-50).

In regard to Claim 6, Fowlow teaches that using the address of a file for the client request of a file on a server is prior art (Column 2, lines 37-53).

In regard to Claim 7, Fowlow teaches using a URL address for identifying software on a server (Column 2, lines 37-53), which is a Globally Unique Identifier. It was shown in Claim 1, that the software attribute is stored in non-volatile memory in the chip card, but Fowlow does not teach storing the attribute in a file. However, a file is a well-known method of storing information in a memory system on a computer, and thus would be an obvious choice for storing the software attribute in a coherent fashion. Claims 21 and 29 correspond with Claim 7 and are rejected for the same reasons as Claim 7.

In regard to Claim 9, Fowlow teaches registering software names on a naming service for client lookup purposes. A table or a database is a well-known method of storing data for future retrieval; the use of a database would have been obvious to one of ordinary skill in the art since a table or database allows for organized data, and fast retrieval.

In regard to Claim 22, a chip card is designed to hold personal information, and the personal information stored on the card is the identifying data stored on the card, and hence is stored on the card when the card is personalized.

In regard to Claim 23, it is obvious to store the identifying data when a user logs on because only when an application is started can it generate and store the data provided by user interaction.

7. Claims 10-13, 15, 19, and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowlow (U.S. Patent Number 6,260,078) in view of Wallace et al. (U.S. Patent Number 6,262,791).

In regard to Claim 10, Fowlow teaches the apparatus of Claim 1, but does not teach that the apparatus for establishing communication is a contact or contact-less card reader. Wallace, however, does teach a card reader, which facilitates communication between a memory card and a host computer (Figure 3, item 13). Claim 19 corresponds to Claim 10 and is rejected for the same reasons as Claim 10.

In regard to Claim 11, Wallace teaches a card reader that facilitates communication between a memory card and a host computer (Figure 3, item 13), which contains the software available for the client.

In regard to Claim 12, Fowlow teaches an object request broker that facilitates communication between a client and a host computer (Column 16, lines 43-47), which contains the software available for the client. Claim 20 corresponds directly with Claims 11 and 12 and is rejected for the same reasons as Claims 11 and 12.

In regard to Claim 13, Fowlow teaches that the agent is a program (Column 5, lines 36-43).

In regard to Claim 15, Fowlow teaches using a protocol between the token and agent is selected, where the protocol selected is the protocol for the particular token (Column 8, lines 27-36).

8. Claim 14 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowlow (U.S. Patent Number 6,260,078) in view of Wallace et al. (U.S. Patent Number 6,262,791) and further in view of Perlman et al. (U.S. Patent Number 6,023,585).

In regard to Claim 14, Fowlow and Wallace teach the apparatus of Claim 13, but do not teach determining the card technology or providing a driver associated with the card. Perlman,



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however, does teach discovering the peripheral technology (Figure 6, item 604) and providing the drivers (Figure 6, item 606). Perlman does not teach reading the address information from the token, determining whether the software is present, or downloading said software from the data-processing device. Fowlow however, does teach reading information from the token (Column 13, lines 20-21) where the information can be an address (Column 2, lines 37-53), determining whether the software is present (Figure 5, items 506 and 508), and downloading the software (Figure 5, items 504, 512, and 514). Claims 24 and 25 correspond directly with Claim 14, and are rejected for the same reasons as Claim 14.

In regard to Claim 26, Perlman teaches that the drivers are stored on the data-processing device (Figure 6, item 604-606).

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowlow (U.S. Patent Number 6,260,078) in view of Powers (U.S. Patent Number 5,521,362) and further in view of DiGiorgio (U.S. Patent Number 6,385,729).

In regard to Claim 16, Fowlow and Powers teach the apparatus of Claim 2, but do not teach communication between the chip card and the agent taking place by means of APDU's. DiGiorgio, however, does teach communication between a token device and a computer system using APDU's (Column 9, lines 1-5).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Murphy et al. (U.S. Patent Number 6,096,096) teaches a portable storage medium which allows a user to download from a server online content.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542.

The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG  
December 20, 2002

  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER